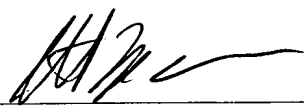
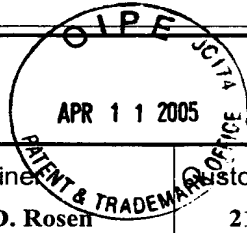


AP/3625

<b>TRANSMITTAL OF APPEAL BRIEF (Small Entity)</b>					Docket No. <b>FF-0113US</b>	
In Re Application Of: <b>Atsushi TESHIMA</b>						
Application No. <b>09/742,362</b>	Filing Date <b>December 22, 2000</b>	Examiner <b>Nicholas D. Rosen</b>	Customer No. <b>21254</b>	Group Art Unit <b>3625</b>	Confirmation No.	
Invention: <b>METHOD AND SYSTEM FOR OPERATING A VIRTUAL SHOPPING MALL OF SELLER-ENGAGED TYPE</b>						
<p><u>COMMISSIONER FOR PATENTS:</u></p> <p>Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:</p> <p><input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27</p> <p>The fee for filing this Appeal Brief is: <b>\$500.00</b></p> <p><input checked="" type="checkbox"/> A check in the amount of the fee is enclosed.</p> <p><input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. <b>50-0481 (Deficiencies Only)</b></p> <p><input type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><b>WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.</b></p> <div style="display: flex; justify-content: space-between; align-items: flex-end; margin-top: 20px;"> <div style="text-align: center;">               _____  <i>Signature</i> </div> <div style="text-align: right;"> <p>Dated: <b>April 11, 2005</b></p> </div> </div> <div style="margin-top: 20px;"> <p><b>Scott M. Tulino, Esq.</b> Registration No. 48,317</p> <p><b>Sean M. McGinn, Esq.</b> Registration No. 34, 386</p> <p><b>McGINN &amp; GIBB, PLLC, Customer No. 21254</b> 8321 Old Courthouse Rd., St. 200, Vienna, VA 22182</p> <p>CC:</p> </div>						
<div style="border: 1px solid black; padding: 5px;"> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on</p> <p>_____ (Date)</p> <p>_____ <i>Signature of Person Mailing Correspondence</i></p> <p>_____ <i>Typed or Printed Name of Person Mailing Correspondence</i></p> </div>						

**TRANSMITTAL OF APPEAL BRIEF (Small Entity)**Docket No.  
**FF-0113US**In Re Application Of: **Atsushi TESHIMA**Application No.  
**09/742,362**Filing Date  
**December 22, 2000**Examiner  
**Nicholas D. Rosen**Customer No.  
**21254**Group Art Unit  
**3625**

Confirmation No.

Invention:

**METHOD AND SYSTEM FOR OPERATING A VIRTUAL SHOPPING MALL OF SELLER-ENGAGED TYPE****COMMISSIONER FOR PATENTS:**

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

☐ Applicant claims small entity status. See 37 CFR 1.27The fee for filing this Appeal Brief is: **\$500.00**

- ☒ A check in the amount of the fee is enclosed.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. **50-0481 (Deficiencies Only)**
- ☐ Payment by credit card. Form PTO-2038 is attached.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

A handwritten signature in black ink, appearing to read "Scott M. Tulino".

*Signature*Dated: **April 11, 2005****Scott M. Tulino, Esq.**  
**Registration No. 48,317****Sean M. McGinn, Esq.**  
**Registration No. 34,386****McGINN & GIBB, PLLC, Customer No. 21254**  
**8321 Old Courthouse Rd., St. 200, Vienna, VA 22182**

CC:

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

(Date)

*Signature of Person Mailing Correspondence**Typed or Printed Name of Person Mailing Correspondence*

Appellant's Brief on Appeal  
U.S. Application Serial No. 09/742,362

1



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

Atsushi Teshima

Serial No.: 09/742,362

Group Art Unit: 3625

Filed: December 22, 2000

Examiner: Nicholas D. Rosen

For: METHOD AND SYSTEM FOR OPERATING A VIRTUAL SHOPPING MALL OF  
SELLER-ENGAGED TYPE

**APPELLANT'S BRIEF ON APPEAL**

Honorable Commissioner of Patents  
Alexandria, Virginia 22313-1450

Sir:

Appellants respectfully appeal the rejection of claims 1-30 in the Non-Final Office  
Action dated January 11, 2005. A Notice of Appeal was timely filed on April 8, 2005.

**I. REAL PARTY IN INTEREST**

The real party in interest is Fuji Photo Film Co., Ltd., assignee of 100% interest of the  
above-referenced patent application.

**II. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to Appellant, Appellant's legal  
representative or Assignee, which would directly affect or be directly affected by or have a  
bearing on the Board's decision in this appeal.

### **III. STATUS OF CLAIMS**

Claims 1-30, all of the claims in the Application, are set forth fully in the attached Appendix.

Claims 1-3 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the article "Electronic Transfer Associates Inc. Announces Details of Worldwide Marketing Agreement with Citron Inc." (hereinafter "Electronic Transfers Associates") in view of the article "Netcentives and the Microsoft Plaza Enter into Agreement to Drive Electronic Commerce," (hereinafter "Netcentives") the article "MICROSOFT: The Microsoft Plaza Brings Product Returns Convenience to Online Shoppers," (hereinafter "Microsoft Plaza"), Galler ("IP: NYT Digital Commerce: Is Delivery the Dealbreaker for E-Commerce?") (hereinafter "Galler") and Cruickshank et al. (U.S. Patent No. 6,522,738; hereinafter "Cruickshank"). Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfers Associates, Netcentives, Microsoft Plaza, Galler and Cruickshank, and further in view of Official Notice. Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of [www.PackageNet.com](http://www.PackageNet.com). Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of Shkedy (U.S. Patent No. 6,260,024). Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of official notice. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of official notice. Claims 11 and 12 stand rejected under 35

U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank official notice, and further in view of the article "eBay Launches the Most Comprehensive Trust and Safety Upgrades to the World's Largest Person-to-Person Trading Site (hereinafter "eBay Launches"). Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of McConnell ("Restaurant No-Shows: Can You Take Them to Court?"; hereinafter "McConnell"). Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco ("Tend the Store for World Wide Orders"; hereinafter "Scisco"), Netcentives, Cruickshank and Galler. Claims 15-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco, Netcentives, Galler and Cruickshank, and further in view of www.PackageNet.com, and Knowles et al. (U.S. Patent No. 5,689,819; hereinafter "Knowles"). Claims 22-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco, Netcentives, Galler, Cruickshank, www.PackageNet.com, and Knowles, and further in view of official notice. Claim 25 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, in view of Galler, Cruickshank and official notice. Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of Scisco. Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of Hess et al. (U.S. Patent No. 6,058,417; hereinafter "Hess"). Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Scisco, Netcentives, Galler, Cruickshank and further in view of Hess. Claim 30 stands rejected under 35 U.S.C. § 103(a) as being

unpatentable over Electronic Transfer Associates, Galler, Cruickshank official notice and further in view of Hess.

Appellant respectfully appeals the above-noted rejections of claims 1-7 and 9-30, which are the sole issues in this Appeal.

#### **IV. STATUS OF AMENDMENTS**

The Examiner mailed a Final Office Action on July 13, 2004 and Applicant filed an Amendment under 37 C.F.R. 1.116 on October 4, 2004. The Examiner mailed an Advisory Action on October 10, 2004 indicating that he would not enter the Amendment.

Applicant filed an RCE on November 15, 2004 and in response thereto, the Examiner mailed an Office Action on January 11, 2005.

An Amendment under 37 C.F.R. § 1.111 was filed on April 5, 2005, editorially amending claims 1, 5, 25 and 30.

A Notice of Appeal was timely filed on April 8, 2005.

Therefore, the claims are pending as set forth in the Appendix, assuming entry of the Amendment filed on April 5, 2005.

#### **V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

The claimed invention, as set forth in exemplary independent claim 1, is directed to a method of operating a virtual shopping mall by using a computer system. The method includes registering virtual goods information, which corresponds to a seller's real goods, to the virtual shopping mall after receiving the virtual goods information from the seller, where registering the virtual goods information includes capturing an image of the real goods as a

part of the virtual goods information, intermediating business between the seller and a buyer on the virtual shopping mall by presenting the virtual goods information to the buyer, setting a delivery path for delivering the real goods from the seller to the buyer in accordance with the buyer's selection of a terminal base, establishing trading between the buyer and the seller, which achieves business on the virtual shopping mall, and presenting each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information.

The claimed invention, as set forth in exemplary independent claim 14, is directed to a virtual shopping mall system, which is established by using a computer system. The virtual shopping mall system includes a commercial goods managing database, which is provided to a seller and registers virtual goods information corresponding to real goods of the seller including capturing an image of the real goods as a part of the virtual goods information, a delivery setting section, which achieves a trade on the virtual shopping mall by setting a delivery path for the real goods, from the seller to a buyer, when a trade has been established between the seller and the buyer who is presented with the virtual goods information in the commercial goods managing database, and an image presenting section for presenting each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information.

The claimed invention, as set forth in exemplary independent claim 25, is directed to a recording medium, which stores a program that can be read by a computer, wherein the program includes a program to operate a virtual shopping mall. The program to operate the virtual shopping mall includes instructions that cause a computer to register virtual goods information corresponding to real goods of a seller to the virtual shopping mall by receiving

the virtual goods information from the seller, the registering virtual goods information including capturing an image of the real goods as a part of the virtual goods information, instructions that cause a computer to intermediate business between the seller and a buyer on the virtual shopping mall by presenting the virtual goods information to the buyer, instructions that cause a computer to achieve a trade on the virtual shopping mall by setting a delivery path of the real goods from the seller to the buyer, and instructions that cause a computer to present each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information (see Application at page 7, lines 21-31).

The non-obvious and unique combination of features provides a method of operating a virtual shopping mall, a virtual shopping mall system and a program (stored on a recording medium) to operate a virtual shopping mall that allows a virtual shopping mall to be operated in a computer system without laying the burden for opening a virtual shop on a goods seller in the virtual shopping mall (e.g., see Application at page 3, lines 7-14).

Referring to the exemplary embodiments of the invention depicted in Figures 12 and 65, a method for operating a virtual shopping mall by using a computer system is provided.

The method includes registering virtual goods information, which corresponds to a seller's real goods, to the virtual shopping mall after receiving the virtual goods information from the seller, where registering the virtual goods information includes capturing an image of the real goods as a part of the virtual goods information (e.g., step S10), intermediating business between the seller and a buyer on the virtual shopping mall by presenting the virtual goods information to the buyer (e.g., steps S30, S40), setting a delivery path for delivering the real goods from the seller to the buyer in accordance with the buyer's selection of a



terminal base (e.g., step S50), establishing trading between the buyer and the seller, which achieves business on the virtual shopping mall (e.g., step S40) (e.g., see Figure 12 and Application at page 23, line 18 through page 24, line 13), and presenting each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information (e.g., step S86) (e.g., see Figure 65 and Application at page 26, line 12 through page 27, line 6).

Referring now to the exemplary embodiments of the invention depicted in Figures 4 and 10, a virtual shopping mall system, which is established by using a computer system, is provided.

The virtual shopping mall system includes a commercial goods managing database (e.g., 24), which is provided to a seller and registers virtual goods information corresponding to real goods of the seller including capturing an image of the real goods as a part of the virtual goods information, a delivery setting section (e.g., 18), which achieves a trade on the virtual shopping mall by setting a delivery path for the real goods, from the seller to a buyer, when a trade has been established between the seller and the buyer who is presented with the virtual goods information in the commercial goods managing database (e.g., see Application at page 17, line 26 through page 18, line 28), and an image presenting section (e.g., see terminal base unit illustrated in Figure 10, and described in the Application on page 26, lines 12-30) for presenting each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information.

As mentioned above, the non-obvious and unique combination of features provides a method of operating a virtual shopping mall, a virtual shopping mall system and a program

(stored on a recording medium) to operate a virtual shopping mall that allows the virtual shopping mall to be operated in a computer system without laying the burden for opening a virtual shop on a goods seller in the virtual shopping mall (e.g., see Application at page 3, lines 7-14).

Each of the features recited in dependent claims 2-13, 15-24 and 26-28 is described in detail in the Specification (e.g., see pages 13-54) and Figures 1-65 of the Application.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The issues presented for review by the Board of Patent Appeals and Interferences are whether claims 1-3 and 6 are patentable under 35 U.S.C. § 103(a) over Electronic Transfers Associates in view of Netcentives, Microsoft Plaza, Galler and Cruickshank, whether claim 4 is patentable under 35 U.S.C. § 103(a) over Electronic Transfers Associates, Netcentives, Microsoft Plaza, Galler and Cruickshank, and further in view of official notice, whether claim 5 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of www.PackageNet.com, whether claim 7 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of Shkedy, whether claim 9 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of official notice, whether claim 10 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of official notice, whether claims 11 and 12 are patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank official notice, and further in

view of eBay Launches, whether claim 13 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of McConnell, whether claim 14 is patentable under 35 U.S.C. § 103(a) over Scisco, Netcentives, Cruickshank and Galler, whether claims 15-21 are patentable under 35 U.S.C. § 103(a) over Scisco, Netcentives, Galler and Cruickshank, and further in view of www.PackageNet.com, and Knowles, whether claims 22-24 are patentable under 35 U.S.C. § 103(a) over Scisco, Netcentives, Galler, Cruickshank, www.PackageNet.com, and Knowles, and further in view of official notice, whether claim 25 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, in view of Galler, Cruickshank and official notice, whether claims 26 and 27 are patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of Scisco, whether claim 28 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of Hess, whether claim 29 is patentable under 35 U.S.C. § 103(a) over Scisco, Netcentives, Galler, Cruickshank and further in view of Hess, and whether claim 30 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Galler, Cruickshank official notice and further in view of Hess.

## **VII. ARGUMENT**

### **A. THE EXAMINER'S POSITION**

In the Office Action mailed January 11, 2005, the Examiner rejected claims 1-3 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfers Associates in view of Netcentives, Microsoft Plaza, Galler and Cruickshank (5 references).

The Examiner alleged that “*Cruickshank teaches presenting a list of (apparently all) objects in a web page to be modified, the objects including graphic image objects*” (see Office Action mailed January 11, 2005, at page 6).

The Examiner also rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Scisco, Netcentives, Cruickshank and Galler.

The Examiner alleged that “*Cruickshank teaches presenting a list of (apparently all) objects in a web page to be modified, the objects including graphic image objects*” (see Office Action mailed January 11, 2005, at page 16).

The Examiner also rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over Electronic Transfer Associates, in view of Galler, Cruickshank and official notice.

The Examiner alleged that “*Cruickshank teaches presenting a list of (apparently all) objects in a web page to be modified, the objects including graphic image objects*” (see Office Action mailed January 11, 2005, at page 22).

## **B. APPELLANT'S POSITION**

To summarize, Appellant submits that the Examiner's position is flawed as a matter of fact and law. Thus, claims 1-3 and 6 are patentable under 35 U.S.C. § 103(a) over Electronic Transfers Associates in view of Netcentives, Microsoft Plaza, Galler and Cruickshank, claim 4 is patentable under 35 U.S.C. § 103(a) over Electronic Transfers Associates, Netcentives, Microsoft Plaza, Galler and Cruickshank, and further in view of official notice, claim 5 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of www.PackageNet.com, claim 7 is patentable under 35 U.S.C. § 103(a) over Electronic

Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of Shkedy, claim 9 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of official notice, claim 10 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of official notice, claims 11 and 12 are patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank official notice, and further in view of eBay Launches, claim 13 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of McConnell, claim 14 is patentable under 35 U.S.C. § 103(a) over Scisco, Netcentives, Cruickshank and Galler, claims 15-21 are patentable under 35 U.S.C. § 103(a) over Scisco, Netcentives, Galler and Cruickshank, and further in view of [www.PackageNet.com](http://www.PackageNet.com), and Knowles, claims 22-24 are patentable under 35 U.S.C. § 103(a) over Scisco, Netcentives, Galler, Cruickshank, [www.PackageNet.com](http://www.PackageNet.com), and Knowles, and further in view of official notice, claim 25 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, in view of Galler, Cruickshank and official notice, claims 26 and 27 are patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of Scisco, claim 28 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and further in view of Hess, claim 29 is patentable under 35 U.S.C. § 103(a) over Scisco, Netcentives, Galler, Cruickshank and further in view of Hess, and claim 30 is patentable under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Galler, Cruickshank official notice and further in view of Hess.

- i) **Independent claim 1 (as well as claims 2-4, 6-9 and 10 which depend from claim 1) are patentable over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler and Cruickshank under 35 U.S.C. § 103(a).**

**1. INDEPENDENT CLAIM 1**

**a. The Examiner's Position is Flawed as a Matter of Fact and Law.**

The Examiner alleged that Electronic Transfer Associates would have been combined with Netcentives, Microsoft Plaza, Galler and Cruickshank to form the claimed invention of claims 1-3 and 6. Appellant submits, however, that these references would not have been combined and that, even if combined, would not teach or suggest each and every element of the claimed invention.

Appellant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely stated that "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellant's invention to set a delivery path for delivering said real goods from said seller to said buyer by said buyer's selection of a terminal base, for the obvious advantage of shipping to locations convenient for the buyers".

However, Appellant respectfully submits that the large number (5 references) of references relied upon by the Examiner clearly shows that Appellant's claimed invention is non-obvious and that the Examiner's position is based on impermissible hindsight.

Furthermore, contrary to the Examiner's allegations none of these references teaches or suggests the inventive combination.

On the other hand, all of the above publications merely disclose a general concept about electronic malls, package delivery, and e-commerce services.

More specifically, Electronic Transfer Associates is related to "click-on-banners" on third party websites that direct people to a website for purchasing a vendor's goods associated with the "click-on banner". Netcentives is directed to a click-rewards program for offering consumer added value when they shop online. Microsoft Plaza is related to a return system for online purchases. Galler is directed to a product delivery service for online purchases and does not even mention a virtual shopping mall. Finally, Cruickshank is directed to an apparatus for improved data image modification by users through telephone station apparatus control. Hence, the cited references are directed to different problems that are completely unrelated to the claimed invention.

In addition, Appellant strongly urges that the Examiner has just "picked and chosen" each element from numerous (e.g., five) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the five publications are clearly unreasonable. Therefore, Appellant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Furthermore, the Examiner's motivation to modify Electronic Transfer Associates, by combining Cruickshank, ("for the obvious advantage of reminding the seller of all the images, assisting the seller in deleting, replacing, modifying, or leaving unchanged the various images, as may be appropriate") is not a problem in Electronic Transfer Associates that would require a solution. Thus, as pointed out in MPEP 2143.01, the Examiner's

motivation is "improper". "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in MPEP).

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests "*presenting each of said images, which are included in said virtual goods information of a plurality of registered real goods, to said seller when said seller requests to modify said virtual goods information*" as recited in claim 1.

The Examiner alleged that Cruickshank teaches presenting each of the images included in the virtual goods information to the seller when the seller requests to modify the virtual goods information. The Examiner attempted to rely on column 8, lines 32-48 of Cruickshank to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this passage (nor anywhere else for that matter) does Cruickshank teach or suggest presenting each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information. Indeed, the Examiner merely stated that Cruickshank teaches presenting a list of objects in a web page to be modified. The Examiner then stated that Cruickshank teaches that "apparently all" of the objects are presented.

Cruickshank merely teaches that the system provides a list of objects that can be modified by the user, based on access rights (see Cruickshank at column 8, lines 32-42). Nowhere, however, does Cruickshank teach that all of the images are presented to the seller. Cruickshank only presents those images that can be modified. The Examiner even conceded that Cruickshank does not teach that all of the images are presented to the seller by stating



that the list in Cruickshank presents “apparently all”. Thus, after combining five references it was still necessary for the Examiner to read additional features into the alleged combination of references.

Furthermore, none of the cited references, nor any combination thereof, teaches or suggests “*registering virtual goods information including capturing an image of said real goods as a part of said virtual goods information*” as recited in claim 1.

In the Examiner's rejection of claim 2, the Examiner merely alleged that Electronic Transfer Associates “implies having captured an image of the real goods”. However, the Examiner does not provide any support in Electronic Transfer Associates, or any of the other four cited references, as actually teaching this claimed feature.

Therefore, Appellant respectfully submits that the alleged combination of references does not teach or suggest each and every feature of the claimed invention of exemplary claim 1.

For at least the foregoing reasons, Appellant respectfully submits that, as a matter of fact, the Examiner has mischaracterized the features of the cited prior art references. Moreover, the cited prior art references would not have been combined as alleged by the Examiner and, even if combined, the alleged combination clearly does not render obvious, all of the features of the claimed invention, as a matter of law.

Therefore, the claimed invention of independent claim 1 (as well as dependent claims 2, 3 and 6 which depend from claim 1) is not obvious in view of the cited references, or any combination of the cited references.

Therefore, Appellants respectfully submit that the Examiners' position is clearly unreasonable.

**2. DEPENDENT CLAIM 4**

**a. The Examiner's Position is Flawed as a Matter of Fact  
and Law.**

The Examiner alleged that Electronic Transfers Associates, Netcentives, Microsoft Plaza, Galler and Cruickshank, in view of official notice, would have been combined to form the claimed invention of claim 4.

In reference to claim 4, the Examiner stated that "*official notice is taken that it is well known to demagnify images and present demagnified [images] to a viewer of a website*".

The Examiner has inappropriately taken official notice in this case. Specifically, the Examiner cannot take official notice of presenting demagnified images to a viewer.

According to MPEP §2144.03, official notice that is unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known are capable of instant and unquestionable demonstration as being well-known. Furthermore, general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support those findings will not support an obviousness rejection (See MPEP §2144.03). Finally, if official notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge (See MPEP §2144.03). In the present Office Action, the Examiner does not supply any specific factual findings or concrete evidence to support his obviousness rejections based on official notice.

Therefore, dependent claim 4 (like independent claim 1) includes at least one element which is not taught or suggested by any of the cited references, or any combination of the cited references.

Therefore, Appellants respectfully submit that the Examiners' position is clearly unreasonable.

### **3. DEPENDENT CLAIM 9**

#### **a. The Examiner's Position is Flawed as a Matter of Fact and Law.**

The Examiner alleged that Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler and Cruickshank, in view of official notice, would have been combined to form the claimed invention of claim 9.

In reference to claim 9, the Examiner stated that "*Official Notice is taken that it is well known to give volume discounts, and to maintain databases of information. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellant's invention to set the fee for the virtual shopping mall lower for those sellers whose amount of past trades stored in the seller's database is large, for the obvious reason of encouraging sellers to do business through the virtual shopping mall.*"

The Examiner has inappropriately taken official notice in this case. Specifically, the Examiner cannot take official notice of a system for providing volume discounts in a virtual shopping mall.

According to MPEP §2144.03, official notice that is unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known are

capable of instant and unquestionable demonstration as being well-known. Furthermore, general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support those findings will not support an obviousness rejection (See MPEP §2144.03). Finally, if official notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge (See MPEP §2144.03). In the present Office Action, the Examiner does not supply any specific factual findings or concrete evidence to support his obviousness rejections based on official notice.

Therefore, dependent claim 9 (like independent claim 1) includes at least one element which is not taught or suggested by any of the cited references, or any combination of the cited references.

Therefore, Appellants respectfully submit that the Examiners' position is clearly unreasonable.

**4. DEPENDENT CLAIM 10**

**a. The Examiner's Position is Flawed as a Matter of Fact and Law.**

The Examiner alleged that Electronic Transfer Associates, Netcentives, Microsoft Plaza and Galler, in view of official notice, would have been combined to form the claimed invention of claim 10.

In reference to claim 10, the Examiner stated that "*Official Notice is taken that it is well known to inspect goods. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellant's invention to inspect the goods, for such obvious advantages as assuring that the goods a business is shipping are what was ordered, and of good quality, so as to avoid complaints, lawsuits and the need to replace defective goods, and to maintain a reputation for quality*".

The Examiner has inappropriately taken official notice in this case. Specifically, the Examiner cannot take official notice of a system for inspecting goods.

According to MPEP §2144.03, official notice that is unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well-known are capable of instant and unquestionable demonstration as being well-known. Furthermore, general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support those findings will not support an obviousness rejection (See MPEP §2144.03). Finally, if official notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge (See MPEP §2144.03). In the present Office Action, the Examiner does not supply any specific factual findings or concrete evidence to support his obviousness rejections based on official notice.

Therefore, dependent claim 10 (like independent claim 1) includes at least one element which is not taught or suggested by any of the cited references, or any combination of the cited references.

Therefore, Appellants respectfully submit that the Examiners' position is clearly unreasonable.

- ii) **Dependent claim 5 is not made obvious under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, Galler and www.PackageNet.com**

**1. DEPENDENT CLAIM 5**

- a. **The Examiner's Position is Flawed as a Matter of Fact and Law.**

The Examiner alleged that www.PackageNet.com would have been combined with Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, and Galler to form the claimed invention of claim 5. Appellant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Appellant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner.

Indeed, the Examiner merely stated that "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellant's invention to have the trading include the seller's setting said terminal base at one of said plurality of real terminal bases to bring in said real goods, for the obvious advantage of enabling said real goods to be conveniently shipped to the buyer".

However, Appellant respectfully submits that the large number of references relied upon by the Examiner suggests that Appellant's claimed invention is non-obvious.

Furthermore, www.PackageNet.com is directed to delivery of online purchases and does not even mention a virtual shopping mall. The cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Appellant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner.

In addition, Appellant strongly urges that the Examiner has just "picked and chosen" each element from numerous (e.g., six) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the six publications are clearly unreasonable. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Furthermore, the Examiner's motivation to modify Electronic Transfer Associates, by combining www.PackageNet.com, (for "enabling said real goods to be conveniently shipped to the buyer") is not a problem in Electronic Transfer Associates that would require a solution. Thus, as pointed out in MPEP 2143.01, the Examiner's motivation is "improper". "The mere fact that references can be combined of modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in MPEP).

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests "*presenting each of said images, which are included in said virtual goods information of a plurality of registered real goods, to said seller when said seller requests to modify said virtual goods information*" as recited in claim 1.

The Examiner did not even allege that www.PackageNet.com teaches or suggests presenting each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information. Indeed, the Examiner merely relied on www.PackageNet.com as teaching that the seller brings a package to one of a plurality of terminals. Thus, www.PackageNet.com fails to make up for the deficiencies of Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, and Galler.

Therefore, Appellant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Thus, claim 5 (based on at least its dependency from claim 1) is not obvious in view of the cited prior art references, or any combination of the cited prior art references.

Therefore, the Examiner's position is clearly unreasonable.

**iii) Dependent claim 7 is not made obvious under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, Galler and Shkedy**

**1. DEPENDENT CLAIM 7**

**a. The Examiner's Position is Flawed as a Matter of Fact and Law.**

The Examiner alleged that Shkedy would have been combined with Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, and Galler to form the claimed invention of claim 7. Appellant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.



Appellant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellant's invention to present said virtual goods information to said buyer so as to secure anonymity of said seller, for the stated advantage of enabling sellers, for numerous privacy and competitive reasons, not to have their identities revealed".

However, Appellant respectfully submits that the large number of references relied upon by the Examiner suggests that Appellant's claimed invention is non-obvious.

Furthermore, Shkedy is directed to a method and apparatus for providing a system of bi-lateral multi-buyer driven electronic commerce that offers the capability for individual buyers to aggregate their purchase orders into pooled orders and does not even mention a virtual shopping mall. The cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Appellant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

On the other hand, all of the above publications merely disclose a general concept about electronic malls, package delivery, and e-commerce services.

In addition, Appellant strongly urges that the Examiner has just "picked and chosen" each element from numerous (e.g., six) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the six publications are clearly unreasonable. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Furthermore, the Examiner's motivation to modify Electronic Transfer Associates, by combining Shkedy, (for "enabling sellers, for numerous privacy and competitive reasons, not to have their identities revealed") is not a problem in Electronic Transfer Associates that would require a solution. Thus, as pointed out in MPEP 2143.01, the Examiner's motivation is "improper". "The mere fact that references can be combined of modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in MPEP).

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests "*presenting each of said images, which are included in said virtual goods information of a plurality of registered real goods, to said seller when said seller requests to modify said virtual goods information*" as recited in claim 1.

The Examiner did not even allege that Shkedy teaches or suggests presenting each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information. Indeed, the Examiner merely relied on Shkedy as teaching conducting electronic commerce wherein an intermediary secures the anonymity of the sellers. Thus, Shkedy fails to make up for the deficiencies of Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, and Galler.

Therefore, Appellant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Therefore, Appellant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Thus, claim 7 (based on at least its dependency from claim 1) is not

obvious in view of the cited prior art references, or any combination of the cited prior art references.

Therefore, the Examiner's position is clearly unreasonable.

- iv) **Dependent claims 11 and 12 are not made obvious under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruikshank, Galler and eBay Launches**

**1. DEPENDENT CLAIMS 11 and 12**

**a. The Examiner's Position is Flawed as a Matter of Fact and Law.**

The Examiner alleged that eBay Launches would have been combined with Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, and Galler in view of official notice to form the claimed invention of claims 11 and 12. Appellant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Appellant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, Appellant respectfully submits that the large number of references relied upon by the Examiner suggests that Appellant's claimed invention is non-obvious.

Furthermore, eBay Launches is directed to promoting safe online trading and does not even mention a virtual shopping mall. The cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore, Appellant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the

references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

On the other hand, all of the above publications merely disclose a general concept about electronic malls, package delivery, and e-commerce services.

In addition, Appellant strongly urges that the Examiner has just "picked and chosen" each element from numerous (e.g., six) publications (and official notice), which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the six publications (and official notice) are clearly unreasonable. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Furthermore, the Examiner's motivation to modify Electronic Transfer Associates, by combining eBay Launches, (for "detering attempts to register inappropriate goods") is not a problem in Electronic Transfer Associates that would require a solution. Thus, as pointed out in MPEP 2143.01, the Examiner's motivation is "improper". "The mere fact that references can be combined of modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis in MPEP).

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests "*presenting each of said images, which are included in said virtual goods information of a plurality of registered real goods, to said seller when said seller requests to modify said virtual goods information*" as recited in claim 1.

The Examiner did not even allege that eBay Launches teaches or suggests presenting each of the images, which are included in the virtual goods information of a plurality of

registered real goods, to the seller when the seller requests to modify the virtual goods information. Indeed, the Examiner merely relied on eBay Launches as teaching conducting electronic commerce wherein an intermediary secures the anonymity of the sellers. Thus, eBay Launches fails to make up for the deficiencies of Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, and Galler.

Furthermore, regarding the rejection of claim 11, the Examiner stated that eBay launches does not “expressly disclose giving a penalty based on a predetermined penalty rule on said virtual shopping mall against said seller in such a case, but does disclose giving a penalty based on a predetermined penalty rule for skill bidders and for bidders who do not honor their commitments”. The Examiner further stated that “it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellant’s invention to give a penalty based on a predetermined penalty rule on said virtual shopping mall against a seller if said seller requests to register inappropriate virtual goods information”. The Examiner however failed to provide a reference to support this allegation.

Thus, even after combining six references and official notice, it was still necessary for the Examiner to read an additional limitation into the alleged combination that is not taught or suggested by any of the six prior art references.

Therefore, Appellant submits that none of the cited references, nor any combination thereof, teaches or suggest “*giving a penalty based on a predetermined rule on said virtual shopping mall against said seller if said seller requests inappropriate virtual goods information*” as recited in claim 11.

Therefore, dependent claims 11 and 12 (like independent claim 1) include at least one element which is not taught or suggested by any of the cited references, or any combination of the cited references.

Therefore, Appellants respectfully submit that the Examiners' position is clearly unreasonable.

- v) **Dependent claim 13 is not made obvious under 35 U.S.C. § 103(a) over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, Galler and McConnell**

**1. DEPENDENT CLAIM 13**

- a. The Examiner's Position is Flawed as a Matter of Fact and Law.**

The Examiner alleged that McConnell would have been combined with Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, and Galler to form the claimed invention of claim 13. Appellant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Appellant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, Appellant respectfully submits that the large number of references relied upon by the Examiner suggests that Appellant's claimed invention is non-obvious.

Furthermore, McConnell is directed to enforcing a contract against a customer who does not show-up at a restaurant after making a reservation. The cited references are directed to different problems that are completely unrelated to the claimed invention. Therefore,

Appellant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

On the other hand, all of the other above publications merely disclose a general concept about electronic malls, package delivery, and e-commerce services.

In addition, Appellant strongly urges that the Examiner has just “picked and chosen” each element from numerous (e.g., six) publications (and official notice), which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the six publications (and official notice) are clearly unreasonable. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Furthermore, the Examiner's motivation to modify Electronic Transfer Associates, by combining McConnell, (for “discouraging people from imposing costs on a seller or agent by arranging to pick up goods at a particular location to which goods are shipped, and then failing to arrive”) is not a problem in Electronic Transfer Associates that would require a solution. Thus, as pointed out in MPEP 2143.01, the Examiner's motivation is “improper”. “The mere fact that references can be combined of modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (emphasis in MPEP).

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests “*presenting each of said images, which are included in said virtual goods information of a plurality of registered real goods, to said*

*seller when said seller requests to modify said virtual goods information” as recited in claim 1.*

The Examiner did not even allege that McConnell teaches or suggests presenting each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information.

Indeed, the Examiner merely relied on McConnell as teaching blacklisting potential buyers who have failed to arrive to receive real goods. Thus, McConnell fails to make up for the deficiencies of Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, and Galler.

Furthermore, Appellant submits that none of the cited references, nor any combination thereof, teaches or suggest *“forming a blacklist, which comprises a list of buyers who have failed to arrive to receive said real goods despite that a trade on said virtual shopping mall has been established”* as recited in claim 13.

The Examiner attempted to rely on the Abstract of McConnell to support his allegation. The Examiner, however, is clearly incorrect.

That is, nowhere in the Abstract does McConnell teach or suggest this feature. McConnell merely teaches creating a black list for people who fail to show-up for a dinner reservation.

Therefore, Appellant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Thus, claim 13 (based on at least its dependency from claim 1) is not obvious in view of the cited prior art references, or any combination of the cited prior art references.

Therefore, the Examiner's position is clearly unreasonable.



- vi) **Independent claim 14 (as well as claims 26 and 27, which depend from claim 1) are patentable in over Electronic Transfer Associates, Netcentives, Galler, Cruickshank and Cisco under 35 U.S.C. § 103(a).**

**1. INDEPENDENT CLAIM 14**

- a. The Examiner's Position is Flawed as a Matter of Fact and Law.**

The Examiner alleged that Cisco would have been combined with Netcentives, Cruickshank and Galler to form the claimed invention of claim 14. Appellant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Appellant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellant's invention to include a delivery setting section, which achieves a trade on said virtual shopping mall by setting a delivery path for said real goods, from said seller to said buyer, when a trade has been established between said seller and said buyer".

However, Appellant respectfully submits that the large number of references relied upon by the Examiner suggests that Appellant's claimed invention is non-obvious. Particularly, Cisco states "using only my browser, Clayton and I built a store in one afternoon". This explicitly encourages a user to use some form of builders to open a shop.

This teaches away from the claimed invention because opening a shop on the virtual mall by using a storefront builder lays the burden on the seller.

Furthermore, the cited references are directed to different problems that are completely unrelated to the claimed invention. Additionally, Scisco requires the seller to use a virtual storefront builder. Therefore, Appellant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

In addition, Appellant strongly urges that the Examiner has just “picked and chosen” each element from numerous (e.g., five) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the five publications are clearly unreasonable. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Furthermore, the Examiner's motivation to modify Electronic Transfer Associates, by combining Scisco, (for “enabling a seller to make arrangements to sell his goods without requiring him to register his virtual goods information”) is not a problem in Electronic Transfer Associates that would require a solution. Thus, as pointed out in MPEP 2143.01, the Examiner's motivation is “improper”. “The mere fact that references can be combined of modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (emphasis in MPEP).

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests “*presenting each of said images, which are included in said virtual goods information of a plurality of registered real goods, to said*

*seller when said seller requests to modify said virtual goods information” as recited in claim 1 and similarly recited in claim 14.*

The Examiner did not even allege that Scisco teaches or suggests presenting each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information. Indeed, the Examiner merely relied on Scisco as teaching registering a seller for selling virtual goods and reserving a space for presenting the virtual goods upon the registration. Thus, Scisco fails to make up for the deficiencies of Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, and Galler.

Therefore, the claimed invention of independent claim 14 (as well as dependent claims 26 and 27 which depend from claim 1) is not obvious in view of the cited references, or any combination of the cited references.

Therefore, Appellants respectfully submit that the Examiners' position is clearly unreasonable.

- vi) **Dependent claim 28 is patentable over Electronic Transfer Associates, Netcentives, Microsoft Plaza, Galler, Cruickshank and Hess under 35 U.S.C. § 103(a) and dependent claim 29 is patentable over Scisco, Netcentives, Galler, Cruickshank and Hess under 35 U.S.C. § 103(a).**

**1. DEPENDENT CLAIMS 28 and 29**

- a. **The Examiner's Position is Flawed as a Matter of Fact and Law.**

The Examiner alleged that Hess would have been combined with Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, and Galler to form the claimed invention of claim 28. Furthermore, the Examiner alleged that Hess would have been combined with Scisco, Netcentives, Galler and Cruickshank to form the claimed invention of claim 29. Appellant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Appellant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, Appellant respectfully submits that the large number of references relied upon by the Examiner suggests that Appellant's claimed invention is non-obvious.

Appellant strongly urges that the Examiner has just "picked and chosen" each element from numerous (e.g., six) publications, which are clearly improper to reject the claims. Furthermore, no motivation is found in the disclosures of these references to combine one another. Again, the prior art rejections based on the six publications are clearly unreasonable. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests "*presenting each of said images, which are included in said virtual goods information of a plurality of registered real goods, to said seller when said seller requests to modify said virtual goods information*" as recited in claim 1 and similarly recited in claim 14.

The Examiner did not even allege that Hess teaches or suggests presenting each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information. Indeed, the Examiner merely relied on Hess as teaching a virtual shopping mall operated by a computer system, where sellers register goods information. Thus, Hess fails to make up for the deficiencies of Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, Scisco and Galler.

Therefore, Appellant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Thus, claims 28 and 29 (based on at least their dependency from claim 14) are not obvious in view of the cited prior art references, or any combination of the cited prior art references.

Therefore, the Examiner's position is clearly unreasonable.

- vii) **Dependent claims 15-21 are patentable over Scisco, Netcentives, www.PackageNet.com, Galler, Cruickshank and Knowles under 35 U.S.C. § 103(a) and dependent claims 22-24 are patentable over Scisco, Netcentives, www.PackageNet.com, Galler, Cruickshank and Knowles, in view of official notice, under 35 U.S.C. § 103(a).**

**1. DEPENDENT CLAIMS 15-21**

- a. The Examiner's Position is Flawed as a Matter of Fact and Law.**

The Examiner alleged that Knowles would have been combined with Netcentives, Scisco, Cruickshank, Galler and www.PackageNet.com to form the claimed invention of claims 15-21. Appellant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Appellant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellant's invention to have the virtual shopping mall system comprise a plurality of terminal base units, installed at a plurality of real terminal bases that perform a physical distribution system".

However, Appellant respectfully submits that the large number of references relied upon by the Examiner suggests that Appellant's claimed invention is non-obvious.

Furthermore, Knowles is directed to an Internet based system for tracking objects having URL-encoded bar codes and does not even mention a virtual shopping mall. The cited references are directed to different problems that are completely unrelated to the

claimed invention. Therefore, Appellant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests "*presenting each of said images, which are included in said virtual goods information of a plurality of registered real goods, to said seller when said seller requests to modify said virtual goods information*" as recited in claim 1 and similarly recited in claim 14.

The Examiner did not even allege that Knowles teaches or suggests presenting each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information.

Thus, Knowles fails to make up for the deficiencies of Electronic Transfer Associates, Netcentives, Microsoft Plaza, Cruickshank, Scisco and Galler.

Therefore, Appellant submits that these references, even if combined, would not teach or suggest each and every element of the claimed invention. Thus, claims 15-21 (based on at least their dependency from claim 14) are not obvious in view of the cited prior art references, or any combination of the cited prior art references.

Therefore, the Examiner's position is clearly unreasonable.

**2. DEPENDENT CLAIMS 22-24**

**a. The Examiner's Position is Flawed as a Matter of Fact and Law.**

The Examiner alleged that Knowles would have been combined with Scisco, Netcentives, Cruickshank, Galler and www.PackageNet.com, in view of official notice, to form the claimed invention of claims 22-24.

In reference to claim 22, the Examiner states that "*Official Notice is taken that it is well known to lease equipment and thus to manage information about leasing.*"

In reference to claim 23, the Examiner states that "*Official Notice is taken that catalog printing apparatus is well known*".

In reference to claim 24, the Examiner states that "*Official Notice is taken that searching apparatus in virtual shopping malls is well known*"

Appellant submits that the Examiner has inappropriately taken Official Notice in this case. Specifically, Appellant submits that the Examiner can not take Official Notice of an information managing system for leasing equipment, a catalog printing apparatus and a searching apparatus in a virtual shopping mall.

In the Office Action dated January 11, 2005 the Examiner did not supply any specific factual findings or concrete evidence to support his obviousness rejections based on official notice.

Therefore, dependent claims 22-24 (like independent claim 14) include at least one element which is not taught or suggested by any of the cited references, or any combination of the cited references.



Therefore, Appellants respectfully submit that the Examiners' position is clearly unreasonable.

**viii) Independent claim 25 (and dependent claim 30 which depends therefrom) is patentable over Electronic Transfer Associates, Cruickshank and Galler, in view of official notice, under 35 U.S.C. § 103(a).**

**1. INDEPENDENT CLAIM 25**

**a. The Examiner's Position is Flawed as a Matter of Fact and Law.**

The Examiner alleged that Electronic Transfer Associates, Cruickshank and Galler, in view of official notice, would have been combined to form the claimed invention of claim 25. The Examiner further alleged that Electronic Transfer Associates, Cruickshank and Galler, in view of official notice, would have been combined with Hess to form the claimed invention of claim 30. Appellant submits, however, that these references, even if combined, would not teach or suggest each and every element of the claimed invention.

Appellant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner. Indeed, the Examiner merely states that "it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of Appellant's invention to achieve a trade on said virtual shopping mall by setting a delivery path of said real goods from said seller to said buyer".

However, as stated above, Appellant respectfully submits that the large number of references relied upon by the Examiner suggests that Appellant's claimed invention is non-obvious. Furthermore, the cited references are directed to different problems that are

completely unrelated to the claimed invention. Therefore, Appellant respectfully submits that one of ordinary skill in the art would not have been so motivated to combine the references as alleged by the Examiner. Therefore, the Examiner has failed to make a prima facie case of obviousness.

Moreover, contrary to the Examiner's allegations, none of the cited references, nor any combination thereof, teaches or suggests "*presenting each of said images, which are included in said virtual goods information of a plurality of registered real goods, to said seller when said seller requests to modify said virtual goods information*" as recited in claim 1.

The Examiner alleged that Cruickshank teaches presenting each of the images included in the virtual goods information to the seller when the seller requests to modify the virtual goods information. The Examiner attempts to rely on column 8, lines 32-48 of Cruickshank to support his allegations. The Examiner, however, is clearly incorrect.

That is, nowhere in this passage (nor anywhere else for that matter) does Cruickshank teach or suggest presenting each of the images, which are included in the virtual goods information of a plurality of registered real goods, to the seller when the seller requests to modify the virtual goods information. Indeed, the Examiner merely stated that Cruickshank teaches presenting a list of objects in a web page to be modified. The Examiner then stated that Cruickshank teaches that "apparently all" of the objects are presented.

Cruickshank merely teaches that the system provides a list of objects that can be modified by the user, based on access rights (see Cruickshank at column 8, lines 32-42). Nowhere, however, does Cruickshank teach that all of the images are presented to the seller. Cruickshank only presents those images that can be modified. The Examiner even conceded

that Cruickshank does not teach that all of the images are presented to the seller by stating that the list in Cruickshank presents "apparently all". Thus, after combining five references it was still necessary for the Examiner to read additional features into the alleged combination of references.

Additionally, the Examiner states that "*Official Notice is taken that it is well known to use recording media storing programs to instruct computers to carry out methods*". Again, the Examiner has inappropriately taken official notice in this case. Specifically, Appellant submits that the Examiner cannot take official notice of a recording media storing programs in a virtual shopping mall.

In the present Office Action, the Examiner does not supply any specific factual findings or concrete evidence to support his obviousness rejections based on official notice.

Therefore, the claimed invention of independent claim 25 (as well as dependent claim 30 which depends from claim 25) is not obvious in view of the cited references, or any combination of the cited references.

Therefore, Appellants respectfully submit that the Examiners' position is clearly unreasonable.

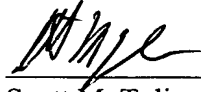
## VIII. CONCLUSION

In view of the foregoing, Appellant submits that claims 1-30, all of the claims presently pending in the application, are patentably distinct from the prior art of record and in condition for allowance. Thus, the Board is respectfully requested to remove the rejections of claims 1-30.

Please charge any deficiencies and/or credit any overpayments necessary to enter this paper to Attorney's Deposit Account number 50-0481.

Date: April 11, 2005

Respectfully Submitted,



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**CLAIMS APPENDIX**

1. A method for operating a virtual shopping mall by using a computer system, comprising:

registering virtual goods information, which corresponds to a seller's real goods, to the virtual shopping mall after receiving said virtual goods information from said seller, said registering virtual goods information including capturing an image of said real goods as a part of said virtual goods information;

intermediating business between said seller and a buyer on said virtual shopping mall by presenting said virtual goods information to a buyer;

setting a delivery path for delivering said real goods ~~form~~ from said seller to said buyer in accordance with said buyer's selection of a terminal base; and

establishing trading between said buyer and said seller, which achieves business on said virtual shopping mall; and

presenting each of said images, which are included in said virtual goods information of a plurality of registered real goods, to said seller when said seller requests to modify said virtual goods information.

2. The method for operating a virtual shopping mall as claimed in claim 1, wherein said business is intermediated by presenting said image to said buyer.

3. The method for operating a virtual shopping mall as claimed in claim 2, further comprising:

selecting by said seller whether to modify said virtual goods information about real goods among a plurality of said real goods presented by said presenting.

4. The method for operating a virtual shopping mall as claimed in claim 3, wherein said presenting disposes each of said images by demagnifying said images and presents demagnified images to said seller.

5. The method for operating a virtual shopping mall as claimed in claim 2, wherein said trading includes said seller's setting said terminal base at least one of a plurality of real terminal bases to bring in said real goods.

6. The method for operating a virtual shopping mall as claimed in claim 2, further comprising:

instructing a physical distribution system, which includes a plurality of real terminal bases, to deliver said real goods.

7. The method for operating a virtual shopping mall as claimed in claim 2, wherein said business is intermediated by presenting said virtual goods information to said buyer as securing anonymity of said seller.

8. The method for operating a virtual shopping mall as claimed in claim 1, further comprising:

setting a maximum value of a number of categories of said virtual goods, which can be displayed on said virtual shopping mall, according to a fee charged to said seller.

9. The method for operating a virtual shopping mall as claimed in claim 1, further comprising:

updating a seller's database when said trading is established,

wherein the computer system stores a trade history for each of said sellers in said seller's database and setting a fee for said virtual shopping mall lower for sellers whose amount of past trades stored in said seller's database is large.

10. The method for operating a virtual shopping mall as claimed in claim 2, further comprising:

inspecting goods.

11. The method for operating a virtual shopping mall as claimed in claim 10, further comprising:

giving a penalty based on a predetermined penalty rule on said virtual shopping mall against said seller if said seller requests to register inappropriate virtual goods information.

12. The method for operating a virtual shopping mall as claimed in claim 11, wherein said predetermined penalty rule is established to give different penalties against said seller according to the number of registrations of said inappropriate virtual goods information.

13. The method for operating a virtual shopping mall as claimed in claim 2, further comprising:

forming a black list, which comprises a list of buyers who have failed to arrive to receive said real goods despite that a trade on said virtual shopping mall has been established.

14. A virtual shopping mall system, which is established by using a computer system, comprising:

a commercial goods managing database, which is provided to a seller and registers virtual goods information corresponding to real goods of said seller including capturing an image of said real goods as a part of said virtual goods information;

a delivery setting section, which achieves a trade on said virtual shopping mall by setting a delivery path for said real goods, from said seller to a buyer, when a trade has been established between said seller and said buyer who is presented with said virtual goods information in said commercial goods managing database; and

an image presenting section for presenting each of said images, which are included in said virtual goods information of a plurality of registered real goods, to said seller when said seller requests to modify said virtual goods information.

15. The virtual shopping mall system as claimed in claim 14, further comprising:

a plurality of terminal base units, each of which is installed at a real terminal base, the plurality of real terminal bases forming a physical distribution system, said terminal base unit connecting and communicating with a virtual shopping mall operations apparatus that manages said commercial goods managing database.



16. The virtual shopping mall system as claimed in claim 15, further comprising:

a shop managing database, which sets up a virtual shop for selling said goods for each of said sellers on said computer system; and

a section for processing an owner registration procedure for sellers who want to open said virtual shop and be an owner thereof.

17. The virtual shopping mall system as claimed in claim 15, wherein each of said terminal base units functions as a place for a seller to bring real goods and for a buyer to receive said real goods, through communication of information with said virtual shopping mall operations apparatus.

18. The virtual shopping mall system as claimed in claim 15, further comprising:

a section for generating virtual goods information, which generates virtual goods information that corresponds to real goods of a seller who is an owner of a virtual shop.

19. The virtual shopping mall system as claimed in claim 18, wherein said section for generating virtual goods information comprises a media equipment device, which reads image data of real goods from a recording medium.

20. The virtual shopping mall system as claimed in claim 18, wherein said section for generating virtual goods information comprises an image capturing unit, which captures an image of real goods that are brought to said terminal base by said seller.

21. The virtual shopping mall system as claimed in claim 18, wherein said section for generating virtual goods information comprises a picture reading unit, which obtains image data of said real goods from a picture of said real goods brought in to said terminal base by said seller.

22. The virtual shopping mall system as claimed in claim 15, further comprising:

a section for managing, which manages information about leasing to a seller, or an owner of a virtual shop, and

an image capturing unit, which is used for generating virtual goods information that corresponds to real goods.

23. The virtual shopping mall system as claimed in claim 15, further comprising:

a catalog printing apparatus, which prints out a catalog of virtual goods information.

24. The virtual shopping mall system as claimed in claim 15, further comprising:

a section for searching, which searches virtual goods information managed by a virtual shopping mall operations apparatus.

25. A recording medium, which stores a program that can be read by a computer, wherein the program comprises a program to operate a virtual shopping mall, the program comprising:

instructions that cause a computer to register virtual goods information corresponding to real goods of a seller to said virtual shopping mall by receiving said virtual goods

information from said seller, said registering virtual goods information including capturing an image of said real goods as a part of said virtual goods information;

instructions that cause a computer to intermediate business between said seller and a buyer on said virtual shopping mall by presenting said virtual goods information to said buyer;

instructions that cause a computer to achieve a trade on said virtual shopping mall by setting a delivery path of said real goods from said seller to said buyer; and

instructions that cause a computer to present each of said images, which are included in said virtual goods information of a plurality of registered real goods, to said seller when said seller requests to modify said virtual goods information.

26. The method for operating a virtual shopping mall as claimed in claim 1, further comprising:

registering a seller for selling virtual goods; and

reserving a space for presenting said virtual goods upon said registration before registering said virtual goods information.

27. The method for operating a virtual shopping mall as claimed in claim 26, further comprising:

providing a plurality of units, each representing one of said virtual goods, into said space.

28. The method for operating a virtual shopping mall as claimed in claim 1, wherein the virtual shopping mall is operated by the computer system devoid of a seller opening a virtual shop.

29. The virtual shopping mall system according to claim 14, wherein the virtual shopping mall is operated by the computer system devoid of a seller opening a virtual shop.

30. The recording medium according to claim 25, wherein the virtual shopping mall is operated by the computer devoid of a seller opening a virtual shop.

**EVIDENCE APPENDIX**

Not applicable.

**RELATED PROCEEDINGS APPENDIX**

Not applicable.